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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,351	03/31/2000	Francisco Jose Barreras SR.	20060	3225

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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/541,351	BARRERAS ET AL.	
	Examiner	Art Unit	
	Kennedy Schaetzle	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 is/are allowed.
- 6) ☒ Claim(s) 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Recapture

3. Claim 29 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The applicant is attempting to recapture subject matter in claim 29 defined by the limitation pertaining to the second control means that is coupled to the RF energy receiving means, to the rechargeable battery, to the RF signal transmitting means and to the implantable medical device, for adjusting the charging current flowing into the rechargeable battery as a function of (a) the charge level of the rechargeable battery, (b) selected charging rate, and (c) selected power supply for the implantable medical device. In the prosecution history of the original patent, the applicant remarks (see paper no. 6, pages 7-9 of the original patent application) that in light of the anticipatory rejection employing reference Shulman (Pat. No. 3,942,535), the second control means has been defined more specifically, by additionally reciting that the second control means adjusts the charging current flowing into the rechargeable battery as a function of items (a), (b) and (c) above. Such language was said to completely distinguish the claim over the prior art.

Claim Objections

4. Claim 30 is objected to because of the following informalities: a typographical error appears on line 8 of claim 30 ("int9"). Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reference to "...said rechargeable battery..." on line 16 lacks antecedent basis.

Also in claim 28, it is not clear what the quotation marks around the word "stop" on the last line are implying. In interpreting the claim in relation to the prior art, the examiner will assume no quotation marks were intended.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulman (Pat. No. 3,942,535).

Schulman discloses a transmitting unit (comprising the elements shown to the left of the skin barrier as shown in Fig. 1), including a power source 13 and an RF energy transmitting means (generally elements 104 and 42), a receiving unit (comprising the elements shown to the right of the skin barrier as shown in Fig. 1) including an implantable, electrically operated medical device 11, RF energy receiving means 10, and a rechargeable battery 15.

Regarding the recited control means for adjusting the charging current flowing into the rechargeable battery (claims 30 and 31), note in particular the discussion contained in lines 15-40 of col. 5. Transistor Q7 adjusts charging current by judiciously diverting a portion of said current.

Regarding claim 31 and the recited control means for controlling the amount of RF energy transmitted to the receiving unit, Schulman discloses that the output of transducer 14 can be used to control the power oscillator output energy (note in particular col. 3, lines 50-58).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. (Pat. No. 4,082,097).

Mann et al. disclose an RF coupled medical device comprising a transmitting unit (those elements located external to the body such as shown in Fig. 3), and a receiving unit (those elements located internal to the body) including an implantable medical device (the tissue stimulator generally shown as elements 14 and 15). The transmitting unit includes RF energy transmitting means (e.g., coil 19 and the associated drive circuitry), RF energy receiving means (e.g., coil 39 and its associated circuitry) and first control means coupled to the transmitting and receiving means for controlling the amount of RF energy transmitted to the receiving unit (switch 52 and indicator light L_{EOC} which cooperate to control device shut-down). The receiving unit includes RF energy receiving means (e.g., coil 18 and related circuitry), RF signal transmitting means (e.g., coil 38 and oscillator B), and second control means for adjusting the charging current flowing into the rechargeable battery (switch 24, control circuit 25, etc.). The receiving unit further comprises means for measuring the charge level of the battery (element 37), and upon sensing what is considered to be for all intensive purposes a full charge (note for example col. 20, lines 52-63), automatically up-links a signal that commands the transmitting unit to stop transmitting (note in particular col. 20, lines 23-41).

Although the up-linked signal is not disclosed as being "coded," those of ordinary skill in the art would have considered such a feature to be a matter of obvious design simply dependent upon the transmission method employed and the desired sophistication of the receiver/transmitter. The applicants' lack of criticality on this issue lends further support to the obvious design assertion. One could additionally consider the signal "coded" from the fact that it is transmitted at a specific frequency to a receiver specifically designed to receive such a signal.

Allowable Subject Matter

11. Claims 1-27 are allowed.

Regarding claim 1, the prior art of record does not appear to disclose the recited second control means coupled to said RF energy receiving means, to said rechargeable battery, to said RF signal transmitting means and to said implantable medical device, for

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adjusting the charging current flowing into the rechargeable battery as a function of (a) the charge level of the rechargeable battery, (b) selected charging rate, and (c) selected power supply for the implantable medical device.

In claim 23, there does not appear to be any suggestion for modifying the prior art of record to include the recited mode selection means.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaezle whose telephone number is (703) 308-2211. The examiner can normally be reached on M-F from 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

KJS
May 9, 2003


KENNEDY SCHAETZLE
PRIMARY EXAMINER